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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
CHEUNG, CALVIN K				
ART UNIT		PAPER NUMBER		
3621				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/567,642

Applicant(s)

KAWAKAMI, TAKASHI

Examiner

CALVIN K.S. CHEUNG

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2009.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 15-18 is/are pending in the application.
4a) Of the above claim(s) 12-14 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-11 and 15-18 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Acknowledgement

1. This action is in response to the remarks filed on 1 July 2009.
2. This Office Action is given Paper No. 20091106. This Paper No. is for reference purposes only.
3. Claims 1-18 are pending.
4. Claims 12-14 are withdrawn. See Election response filed on 24 March 2008 and acknowledgement in Office Action mailed on 16 April 2008.
5. Claims 1-11 and 15-18 are examined below.

Claim Objections

6. Claims 15-16 are objected to because of the following informalities:
 - a. Claim 15: Line 18 recites "a content ID and group ID", the Examiner particular points to the article "a" and "group ID" as used in the conjunction. It is understood "Group ID" is referencing "the group ID" from line 13; therefore, the phrase on line 18 is interpreted as "a content ID and *the* group ID."
 - b. Claim 16:
 - i. Line 3 recites "a connection decider" where the Original Specification does not support the term "decider" however it is understood by the Examiner as "a connection decision section" which is supported by the Original Specification. Remove "decider" and replace with "decision section" in order to stay consistent with the terminology presented in the Original Specification.

- ii. Line 7 recites "a received" but is understood by the Examiner as "a receiver."
7. Appropriate correction is required.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1, 9, and 15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
10. Regarding Claims 1, 9, 15-18:
- c. Claims 1, 9, 15-18 recite a computer program only. "Computer programs claimed as computers listings per se, i.e., the descriptions or expressions of the programs, are not physical 'things.' They are neither computer components nor statutory processes, as they are not 'acts' being performed." MPEP §2106.01 I. Because the claims recite only abstractions that are neither "things" nor "acts," the claims are not within one of the four statutory categories of invention. 35 U.S.C. §101 defines four categories of invention that Congress deemed to be the appropriate subject matter of a patent: processes, machines, manufactures, and compositions of matter. Because the claims are not within one of the four statutory categories of invention, the claims are rejected under 35 U.S.C. §101.
 - d. Applicants' original specification provides evidence where it expressly states:

- iii. “The components of the content processing apparatus 10 are described. The data communication section 120, group registration section 130, list management section 140, certificate issuance section 150, distribution service utilization section 152, source ID application section 154, content processing section 160, ICV data management section 190, transfer control section and so forth described hereinabove may be formed, for example, as hardware having the functions described hereinabove, or may alternatively be formed by installing a program for implementing the functions described above into the content processing apparatus 10” (Specification p. 84-85, ¶ 158);
- iv. “It is to be noted that the data communication section 220, reproduction control type decision section 240, reproduction permission/inhibition decision section 242, reproduction execution section 244, title list production section 250, content selection section 252 and so forth described hereinabove may be configured, for example, as hardware having the functions described hereinabove or may be configured by installing a program, which causes a computer to implement the functions described hereinabove, into the content reproduction apparatus 20 “ (Specification p. 116-117, ¶ 222); and
- v. Lastly, “section” as presented in the independent claims are directed to functions from a program such as a software program are found in Figure 5 and Figure 10 where the original specification expressly states “FIG. 5 is a block diagram schematically show functions of the content processing apparatus” (p. 20) and “FIG. 10 is a block diagram schematically showing functions of the

content reproduction apparatus” (p. 20) which differ by comparison from Figure 4 and Figure 9 where the original specification expressly states “FIG. 4 is a block diagram schematically showing an example of a hardware configuration of a content processing apparatus according to the embodiment” (p. 19) and “FIG. 9 is a block diagram schematically showing an example of a hardware configuration of a content reproduction apparatus according to the embodiment” (p. 20).

- e. Because the claimed invention may be interpreted as software only, the claims are not within one of the four statutory categories of invention and are therefore rejected under 35 U.S.C. §101.

Claim Rejections - 35 USC § 112, Second Paragraph

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-11, 15-18 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- f. Regarding Claim 1:

vi. The scope of the claim is directed to a content reproduction apparatus such as demonstrated in light of the drawing Figure 20 and specification; however, the claim exceeds the scope by including other items outside the embodiment of the content reproduction apparatus such as “a management server” and “a content distribution server.” To a person of ordinary skill in the art, it would be indefinite

since the scope of the claim regarding the “apparatus” as stated in the preamble now includes a management server and a distribution server as a part of the content reproduction apparatus’ embodiment. For purposes of examination, the Examiner’s interpretation of the entire claim focuses on hardware features found *only embodied within* the content reproduction apparatus as depicted from Figure 9 not for equipment external to the content reproductions apparatus’ embodiment.

vii. An indefinite limitation found on lines 5 and 7 recites “a content”, and indefinite because a person of ordinary skill in the art would not be able to determine whether the transmitting and receive pertains to a different or same content. For purposes of examination and applying the prior art, the Examiner interprets the phrase on line 7 as a “different content.”

viii. An indefinite limitation found on line 9 recites “a reproduction permission/inhibitor decision section” and indefinite because the section is either set to permit or inhibit, not both. For purposes of examination and applying the prior art, the Examiner interprets the phrase as “a decision section.”

g. Claims 2-8 contain the same discrepancy as claim 1, thus are rejected in like manner.

h. Claim 9:

ix. The scope of the claim is directed to a content processing apparatus such as demonstrated in light of the drawing Figure 4 and specification; however, the claim exceeds the scope by including other items outside the embodiment of the content reproduction apparatus such as “a content reproduction apparatus”, “a

management server”, and “a content distribution server.” To a person of ordinary skill in the art, it would be indefinite since the scope of the claim regarding the “apparatus” as stated in the preamble now includes a content reproduction apparatus, a management server, and a distribution server as a part of the content processing apparatus’ embodiment. For purposes of examination and applying the prior art, the Examiner’s interpretation of the entire claim focuses on hardware features found *only embodied within* the content processing apparatus as depicted from Figure 4 not for equipment external to the content reproductions apparatus’ embodiment.

x. “Connection decision section” on line 2 “connects to a content reproduction apparatus”; however, so does “a first communication section” as cited on lines 6-7. The two (2) sections present an indefinite limitation because one of ordinary skill in the art would not be able to determine which section actually connects to the content reproduction apparatus. The Examiner interprets the limitation by the two sections as “a connection verdict made by the connection decision section informs a first communication section to connect to the content reproduction apparatus.”

xi. “A first communication section” (line 6) and “second communication section” (line 11) both receive and transmit data. However, the claim does not recite language where interaction of these two (2) sections pass the content ID, the content, and the group ID. Further examination also finds indefiniteness according to lines 6-10, the first communication section receives the group ID and content

ID corresponding to content reproduced, but does not actually receive the content from the content reproduction apparatus. One of ordinary skill in the art would not find the content ID equivalent to the content, In other words, content ID is an identifier to identify the content and not considered the content where the content is the media file. It is further indefinite, how data received by the first communication section is delivered into the content storage section because the claim does not provide adequate interaction between these sections. In fact the first communication section only receives "the contents" (line 17) from the content storage section and in turn transmits the contents into the content reproduction apparatus (line 18).

xii. Further analysis of the claim, on line 17, "the contents" according to the claim are not the same as the contents reproduced from line 9 because the contents reproduced are housed within the content reproduction apparatus. The content processing apparatus does not embody the content reproduction apparatus and therefore not the same apparatus. For this reason, "the contents" in the content storage section within the content processing apparatus are different content, thus lacks antecedent basis.

i. Claims 10-11 contain the same discrepancy as claim 9, thus are rejected in like manner.

j. Claim 15:

xiii. The recited term "a permission/inhibitor decision section" is indefinite. In particular, "permission/inhibitor" is indefinite because it is an ambiguous and

confusing description of the a "decision section." To one of ordinary skill in the art would not be able to determine whether this section sole purpose is permit or inhibit use of content.

xiv. "A content" is recited on line 7 and 9 and indefinite because a person of ordinary skill in the art would not be able to determine whether the transmitting and receive pertains to a different or same content. The Examiner interprets the phrase on line 9 as a "different content."

xv. "Based on a group ID" is recited on line 12 and indefinite because one of ordinary skill in the art would not be able to determine whether "based" is matching or inputting the group ID. The Examiner interprets this phrase as "matching the Group ID."

xvi. Analysis of the method provides indefiniteness on interaction between the "permission/inhibitor decision section" and the "content reproduction section" because the reproduction verdict made by the permission/inhibitor decision section is never delivered to the reproduction section. The action is not recited in the claim, thus indefinite because the reproduction verdict is not delivered to the content reproduction section, the content reproduction section will not reproduce content.

xvii. Analysis of the method provides indefiniteness on interaction between the "content reproduction section" and "recording" step (lines 18-19) and the content storage section because the content reproduction section does not have interaction with the content storage section. The claim does not provide interaction among

these section, therefore it is indefinite because the step of submitting content, content ID, and group ID from the content storage section into the content reproduction section is needed to reproduce content.

k. Claim 16;

xviii. Analysis of the method provides indefiniteness on "the content ID" from the content distribution server. Antecedent basis for a content ID from the content reproduction apparatus has been established on line 4, but not for content ID from the content distribution server; therefore this limitation lacks antecedent basis.

xix. Since claim 16 is parallel to claim 9 and directed to the content processing apparatus, it contains the same discrepancies as claim 9 thus rejected in like manner.

l. Claim 17 is parallel to claim 1 and 15 and directed to the content reproduction apparatus, it contains the same discrepancies as claim 1 and 15 and rejected in like manner.

m. Claim 18 is parallel to claim 9 and 16 and directed to the content reproduction apparatus, it contains the same discrepancies as claim 2 and 16 and rejected in like manner.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 9-11, 16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by US 2002/0085721 A1 (hereafter Saneto).

15. Claim 9: Saneto discloses a content processing apparatus (personal computer in Fig. 2), comprising:

n. a connection decision section configured to decide whether to connect to a content reproduction apparatus which stores a group ID produced uniquely according to a user account when said content processing apparatus is registered in the user account in a management server (§ 70-75 and Fig. 2; *“content reproduction apparatus” corresponds to the portable device, and “management server” corresponds to the approval server in Saneto’s teaching. Since the content reproduction apparatus and the management server claimed by the applicant is outside the scope of the content processing apparatus, they bear no patentable weight*);

o. a first communication section configured to communicate with the content reproduction apparatus, when connection is decided by said connection decision section, the first communication section receiving a content ID corresponding to content reproduced by the content reproduction apparatus and the group ID stored in said content reproduction apparatus (§ 70 and Fig. 2; *this limitation corresponds to the personal computer receives ID and password from the approval server*);

p. a second communication section configured to communicate with a content distribution server, the second communication section transmitting the content ID and the group ID to the content distribution server which provides a content download service (§

71, 87 and Fig. 2; *"content distribution server" corresponds to the EMD server in Saneto's teaching; this limitation corresponds to the personal computer registers the ID and password with an ID management server and later on the ID and password are transmitted to the EMD server; Since the content distribution server claimed by the applicant is outside the scope of the content processing apparatus, it bears no patentable weight*); and

q. a content storage section for storing additional content corresponding to the content ID transmitted from said content distribution server and received through said second communication section, the contents stored in said content storage section being transmitted to said content reproduction apparatus through said first communication section (§ 84, 90, 236 and Figs. 2, 19; *this limitation corresponds to the personal computer receives and stores requested content from the EMD server, the received content is transmitted to the portable device*).

r. *(The examiner observes that a plurality of the sections are claimed by the applicant. Since these sections are software per se and all within the content processing apparatus, the examiner interprets all sections as the personal computer in Saneto's teaching).*

16. Claim 10: Saneto discloses:

s. wherein said second communication section receives reliability information corresponding to the group ID from said content distribution server (§ 85), and

t. said first communication section transmits the reliability information received by said second communication section to said content reproduction apparatus (§ 90).

17. Claim 11: Saneto discloses:
- u. wherein said second communication section receives a reliable group ID from said content distribution server (§ 85), and
 - v. said first communication section transmits the received reliable group ID to said content reproduction apparatus (§ 90).
18. Claims 16 and 18 repeat the subject matter of claims 9-11 therefore rejected in like manner.

Allowable Subject Matter

19. Claims 1-8 and 15 would be allowable if rewritten or amended to overcome claim objections and rejections under 35 U.S.C. 101 and 112, 2nd paragraph, set forth in this Office action.
20. In addition, amending Claim 17 to recite the identical limitations from Claim 1 results in a parallel claim, in turn will make it allowable.

Claim Interpretation

21. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard:

w. ***Reproduce*** “vt. d : to present again.” Merriam-Webster’s Collegiate Dictionary, 10th Edition, Merriam-Webster Inc., Springfield, M.A., 1997.

Conclusion

22. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to CALVIN K.S. CHEUNG whose telephone number is (571) 270-7041. The Examiner can normally be reached on Monday - Friday, 8:00a.m. - 5:00p.m., EST.
23. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CALVIN K.S. CHEUNG/
Examiner, Art Unit 3621
6 November 2009

/EVENS J. AUGUSTIN/
Primary Examiner, Art Unit 3621